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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,569	02/10/2004	James A. Roberts	01032-1002	1481

7590 09/30/2005

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EXAMINER

NGUYEN, KIMBERLY D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,569

Applicant(s)

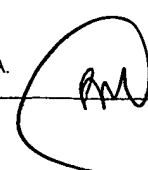
ROBERTS, JAMES A.

Examiner

Kimberly D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The Abstract of the Disclosure is objected to because the use of the legal phraseology, “disclosed”, line 2, is not permitted. Correction is required. See M.P.E.P. § 608.01(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 6-7, 12, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by McCarty et al (US 5,946,660).

Re claim 1: McCarty et al teaches a method for storage services at a retailer facility (14 in figs. 1-2) that sells consumer products, the method comprising the steps of:

receiving a physical media (articles, which is imparted by the consumer; column 1, lines 6-9; column 19-22) from a consumer, wherein the physical media stores content imparted by the consumer;

generating a first identifier (“...the customer first input their customer identification (step 128) i.e. the customer number assigned to the user...” column 10, lines 12-13; column 10, lines 10-30) for identifying the consumer, and a second identifier (i.e., selected unit(s) 18 within the storage facility 14; figs. 2 and 6; column 4, lines 52-59; column 7, line 61 through column 8, line 45) for specifying location of the physical media within the retailer facility;

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storing the physical media (articles) at the location according to the second identifier (selected unit(s) 18); and

charging the consumer for storage of the physical media (column 8, lines 6-16; column 10, lines 43-46).

Re claims 2, 8, and 14: McCarty et al teaches the “articles”, which is broadly interpreted as a non-volatile storage device. Furthermore, the examiner acknowledges the applicant claims that “wherein the physical media *includes* one of a compact disc, a ZIP disk, a hard drive, a diskette, a flash memory card, and other non-volatile storage device.” as set forth in claim 2. However, the claim does not exclude the “articles” as disclosed by McCarty et al, because:

The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) (See MPEP 2111.03 [R-2]).

Accordingly, given its broadest reasonable interpretation, McCarty et al meets the claimed invention.

Re claims 7 and 13: McCarty et al teaches a tracking system for supporting storage services at a retail establishment that includes a storage facility, the system comprising:

a processor (12 in fig. 1; column 4, lines 30-32) configured, in response to receiving a physical media from a consumer, to generate a first identifier for identifying the consumer, and a second identifier for specifying location of the physical media within the retailer facility; and

a database (column 4, lines 30-32) configured to store the generated identifiers, wherein the storage facility stores the physical media at the location according to the second identifier, and the consumer is charged for storage of the physical media (column 4, line 15 through column 9, line 46).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5, 9-11, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al (US 5,946,660) in view of Peoples, Jr. (US 6,098,892). The teachings of McCarty et al have been discussed above.

McCarty et al teaches the step of generating a custom rental agreement(s)/contract(s) having customer information and rented storage unit(s) thereon (column 9, lines 22-46), and displaying/printing the rental agreement(s)/contract(s) to the customer; which serves as the step of generating a plurality of labels corresponding to the first identifier and the second identifier and outputting a receipt for the consumer, the receipt containing the identifiers.

However, McCarty et al fails to teach or fairly suggest the step of affixing one of the labels to the physical media and another one of the labels to the container housing the physical media.

Peoples, Jr. teaches affixing one of the labels (14 in fig. 2) to the bottle (10), which serves as the physical media; and another one of the labels (26 in fig. 4) to a shrink wrapped package (22), which serves as a container, housing the bottles/physical-media (column 1, lines 35-59).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the well known step of affixing a label on the physical

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media/product/objects and another correspondent label on the its container/package as taught by Peoples, Jr. to the teachings of McCarty et al in order to provide corresponding information between the media/product/objects and its container/package to be compared by the receiving party of the container/package by means of comparing the list of items from the container/package and each and every item within the container/package for inventory purposes.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jenkins (US 2002/0188457) discloses Interactive self-storage rental system and method. Roshkoff (US 5,489,123) teaches Packaging label including pre-approved incentive card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'KDN', with a long, sweeping horizontal stroke extending to the right.

KDN

September 26, 2005